REMARKS

Applicant respectfully requests reconsideration of the subject application in light of these remarks and the amendments detailed above. Claim 27 has been amended and new claims 28-31 have been added. As a result, claims 1-31 remain pending. The amendments to the claims have been made in an effort to expedite the prosecution of this matter, without limiting the scope of the invention, and only in an effort to impart precision to the claims (e.g., by more particularly pointing out the invention, rather than to avoid prior art). No new matter is believed to have been introduced hereby.

Claim Rejections – 35 U.S.C §112

Claim 27 stands rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. In particular, claim 27 depends from claim 1 instead of claim 22. As detailed above, this informality has been addressed by amending claim 27 to make a typographical change (namely, claim 27 as amended now depends from claim 22). Accordingly, this rejection is moot.

Claim Rejections – 35 U.S.C §103

Claims 1-27 stand rejected under 35 U.S.C §103(a) over Payne et al. (U.S. Patent No. 5,519,869, hereinafter "Payne") in view of Lerche (U.S. Patent No. 6,457,175, hereinafter "Lerche").

More specifically, the Office Action cites Payne for teaching identifying essential software within a device, the essential software including software necessary to operate the device, identifying remaining portions of the software within the device as non-essential software, and downloading new essential software from

LEE & HAYES, PLLC
RESPONSE TO OFFICE ACTION DATED FEBRUARY 12, 2004

12

ATTORNEY DOCKET NO. MS1-710US
Serial No. 09/755,874

PAGE 13/19 * RCVD AT 5/12/2004 4:40:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:3035390271 * DURATION (mm-ss):04-58

an external source to the device and storing the new essential software in memory. See, the outstanding Office Action, last paragraph of page 2, continuing on to page 3.

Furthermore, the Office Action relies on Lerche to teach a software image that allows a computer to boot including software to provide external communications. Id.

Payne

Payne appears to generally relate to an archiving and restoration system (see, e.g., Payne's abstract). In particular, Payne attempts to address issues with storing data on an external backup device in multiple density formats (see, e.g., column 2, lines 15-29). Payne utilizes a lower density format for archiving a bootstrap image (for compatibility reasons) and a higher density format for archiving the additional software to store more data on a same backup tape (through using an archived file that contains original device density, see, e.g., figure 3, item 42).

Accordingly, Payne is concerned with restoring a system to an archived (i.e., older) state which is stored on a tape in multiple densities. Payne cannot operate properly unless archiving is done by storing the archived file containing original device density. This enables Payne to switch densities during restoration. See, e.g., column 6, lines 7-39.

Lerche

Lerche appears to generally relate to a method and apparatus for installing "a software upgrade" within a memory resource (see, e.g., title and abstract of Lerche). The section identified by the out standing Office Action indicates that Lerche validates a second software image (i.e., the software upgrade) only after it is known

to run successfully through establishing communication with a network device following a reset. See, e.g., column 3, lines 41-45, relied upon by the outstanding Office Action.

Accordingly, Lerche validates a software upgrade by establishing communication.

Improper Combination of Payne and Lerche

It is respectfully submitted that the combination of Payne and Lerche is improper. More specifically, Lerche is concerned with validating software upgrades (i.e., when installing new software), whereas Payne is concerned with archived software restoration (i.e., restoring old software), where proper archiving is required (see, e.g., the discussion above with reference to Payne's archiving requirements). Restoring archived software (as done by Payne) is generally used to ensure business continuity (i.e., adding new functionality is not at issue here). On the other hand, validating software upgrades (as done by Lerche) aims to add new validated functionality to a system.

Accordingly, it is improper to combine Payne's restoration of old software with Lerche's validation of software upgrades (as is done by the outstanding Office Action in rejecting the pending claims). Accordingly, the present rejection of claims 1-27 under 35 U.S.C. §103 is improper.

Unbeneficial Combination of Payne and Lerche

Even if Payne and Lerche were to be combined, the most reasonable combination would result in restoring a system to an archived (i.e., older) state which is stored on a storage device in multiple densities, while updating the system (i.e.,

LEE & HAYES, PLLC   14   ATTORNEY DOCKET NO. MS1-710US
RESPONSE TO OFFICE ACTION DATED FEBRUARY 12, 2004   Serial No. 09/755,874

PAGE 15/19 * RCVD AT 5/12/2004 4:40:19 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:3035390271 * DURATION (mm-ss):04-58

with a software upgrade) only after the new software is validated through establishing communication.

Accordingly, it is respectfully submitted that such a combination fails to teach or suggest the claimed combination of features such as set forth by claim 1. For example, the combination would lack downloading new essential software and storing the new essential software "in memory by overwriting at least a portion of the non-essential software" (as is correctly stated by the outstanding Office Action). Therefore, claim 1 is in condition for allowance.

Claims Rejections

Additionally, it is respectfully submitted that the combination of Payne and Lerche fails to teach or suggest the claimed combination of features such as that set forth by claim 1.

In particular, claim 1 in part recites "downloading new essential software from an external source to the device and storing the new essential software in memory by <u>overwriting at least a portion of the non-essential software</u>." [Emphasis Added.] The Office Action states that the emphasized recitation is not taught by Payne or Lerche. We agree.

The Office, however, goes on to make a statement that this claimed feature is obvious to one with ordinary skill in the art without citing any reference to support this rejection. That is, the Office maintains this claimed feature is obvious, but provides no reference teaching that the new essential software is stored in memory by overwriting at least a portion of the non-essential software.

First, at least one of the cited references (i.e., Payne) appears to utilize multiple volumes for storage (see, e.g., Fig. 1, items 10, 12, 14, and the

corresponding discussion at column 4, lines 15-48) with different types of data stored in each. Hence, Payne would not overwrite "at least a portion of the non-essential software" with the new essential software (since the two types of data would be stored on different volumes). Moreover, Payne discusses utilization of less or more volumes (Id.), but nowhere does it even suggest the claimed feature (as is admitted by the Office Action). Accordingly, the Office's assertion that it would be obvious to overwrite "at least a portion of the non-essential software" is negated by at least one reference that the Office is relying on in rejecting claim 1.

Second, the Office Action rejects at least one claimed feature of all pending claims (e.g., claims 1 and 3 specifically, and claims 9, 17, and 22 by correspondence) in view of allegedly obvious/well-known art. The applicant hereby seasonably traverses these rejections and kindly requests the Examiner to provide a reference in support of these assertions, or to otherwise withdraw the rejections.

Pursuant to M.P.E.P. §2144.03, if the applicant traverses such an assertion, the examiner should cite a reference in support of his or her position. If the Examiner is basing the well-known facts on the Examiner's personal knowledge, the applicant hereby kindly calls upon the Examiner to set forth the facts in an Examiner's affidavit, or to otherwise withdraw the rejections. When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the Examiner (see, e.g., M.P.E.P. §2144.03; 37 C.F.R. §1.104(d)(2)).

Claims 1-31

In light of the above remarks, it is respectfully submitted that claim 1 is improperly rejected (i.e., by an improper combination of cited references and improper rejection based on non-cited art and/or obviousness). Claims 2-8 which depend from claim 1 should be allowable for similar reasons, or for the additional or alternative elements that are recited therein but not shown in the cited prior art.

Furthermore, with respect to claim 4, the Office cites Payne for teaching I/O control units which allow a user to control the computer. Claim 4, however, in part recites that "the device is a managed device." Payne's I/O control units are for managing the storage devices/volumes 10, 12, and 14 of figure 1 (see, e.g., column 4, lines 49-50). If one were to assume that the outstanding rejections are correct and Payne in fact teaches downloading new essential software to memory (such as discussed above with reference to claim 1), the device in question would exclude volumes 10, 12, and 14 because these volumes would be the external source and not the claimed "device." Accordingly, claim 4 is allowable for this additional reason.

Claims 9, 17, 22, and their respective dependent claims (10-16, 18-21, and 23-27) have been summarily rejected by the Office Action for corresponding to claims 1-8. Accordingly, these remaining claims (9-27) should be allowable for at least similar reasons, or for the additional or alternative elements that are recited therein but not shown in the cited prior art.

Similarly, new claims 28-31 should be allowable for similar reasons as the previously pending claims, or for the additional or alternative elements that are recited therein but not shown in the cited prior art.

CONCLUSION

Reconsideration and allowance of all claims is respectfully requested. The Examiner is urged to telephone the undersigned if that would expedite prosecution of the application.

Respectfully Submitted,

Dated: 5/12/04

By: _Brian Hart_

Brian Hart
Reg. No. 44,421
303.539.0265 ext. 241